

Remarks

The instant Office Action dated January 28, 2010, presents the following grounds of rejection: claims 1-5 and 9-17 stand rejected under 35 U.S.C. § 103(a) over Sanford (U.S. Patent No. 6,424,300) in view of Rousu (U.S. Patent Pub. 2003/0114188); and claims 8 and 20 stand rejected under 35 U.S.C. § 103(a) over the '300 and '188 references in view of Schamberger (U.S. Patent Pub. 2003/0117331). Claims 6-7 and 18-19 are objected to but would be allowable if rewritten. Applicant traverses the rejection in the following discussion and without acquiescing to any objection, rationale or averment made in the Office Action.

Applicant traverses the § 103 rejections of claims 1-5, 8-17 and 20. As a first basis for traversing, one would not be motivated to combine the '300 reference and the '188 reference because the '300 reference already solves the problem that the Examiner is asserting as the motivation for combining the two references. Particularly in light of *KSR*, the law under § 103 is clear that one of ordinary skill in the art having common sense at the time of the invention would not have looked to a secondary ('188) reference to solve a problem already solved by the primary ('300) reference. *See, e.g., Ex Parte Rinkevich et al.*, Appeal 20071317, decided May 29, 2007 ("one of ordinary skill in the art having common sense at the time of the invention would not have reasonably looked to [the primary reference] to solve a problem already solved by [the secondary reference]."). The Examiner has asserted one would be motivated to combine the '300 and '188 references in order to provide less current/power consumption. The '188 reference teaches that this is necessary because of the inclusion of a switch to overcome a coupling phenomenon between two same-resonance frequency antenna circuits. *See* paragraphs 0006-0007 of the '188 reference. However, the '300 reference already identified the problem presented in the '188 reference and solves this problem by creating antennas that are small, and isolated from other antennas, without the use of a switch. '300 reference Col. 2:28-42. In place of a switch, isolation is achieved by the two antennas being arranged such that the polarization of the second antenna is nominally orthogonal to that of the primary antenna, and through out of band mismatch. *See*, '300 reference Col. 15:34-40. Accordingly one of skill in the art would not modify the '300

reference with the '188 reference as asserted. Therefore, the § 103 rejection is improper and should be withdrawn.

Applicant further traverses the § 103 rejections of claims 1-5, 8-17 and 20 because the cited references teach away from the Office Action's proposed combination. Consistent with the recent Supreme Court decision, M.P.E.P. § 2143.01 explains the long-standing principle that a § 103 rejection cannot be maintained when the asserted modification undermines either the operation or the purpose of the main ('300) reference - the rationale being that the prior art teaches away from such a modification. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (U.S. 2007). ("[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious."). Applicant submits that the combination would render the invention inoperable because the '300 reference is directed to a device having multiple antennas which serve different purposes and perform different functions. *See, e.g.*, Col. 6:19-22 of the '300 reference. The '300 reference is directed to a system where it is possible to perform one or more of these functions at the same time, which requires the antennas to be on at the same time. For example, the second antenna may be a GPS antenna, which to provide full benefit would need to be on at all times. *See* '300 reference, Col. 2:22-24 ("it [the configuration of antennas] may undesirably disable the GPS function when the cell phone is in a normal talk position"). The Office Action's hypothetical combination includes circuitry to turn off one or more antennas. Accordingly, the operation of the '300 reference device is undermined by the inclusion of a de-activation circuit. Under M.P.E.P. § 2143.01, the rejections cannot be maintained and Applicant requests the § 103(a) rejections of claims 1-5, 8-17 and 20 be withdrawn.

Applicant appreciates that the Examiner has indicated claims 6-7 and 18-19 as being objected to and allowable if rewritten in independent form. However, Applicant submits that amendment to this end is unnecessary as the rejections of the underlying claims are improper.

In view of the above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Juergen Krause-Polstorff, of NXP Corporation at (408) 474-9062.

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